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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,547	12/05/2001	Gregory Allen	24120-08	7198

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Mark Montague, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, NY 10036

EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/004,547	Applicant(s) ALLEN, GREGORY	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6262003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 10/14/2003.
2. Receipt is acknowledged of Ids filed on 6/26/2003.
3. This application claims the benefit of U.S. Provisional Application No. 60/251,610 filed on 12/6/2000.
4. Claims 1-69 are presented for examination.

Oath/Declaration

5. The original oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The original oath or declaration is defective because: The applicant did not sign the oath of the declaration filed on 12/05/2001.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-7, 14-17, 21-27, 33-36, 46-47, 51-52, 58-59, and 63-64 are rejected under 35 U.S.C. 102(e) as being unpatented by Ogasawara (U.S. 6,123,259).

Re claim 1, 46: Ogasawara discloses an electronic shopping system including customer relocation recognition, which includes a portable device or customer card (i.e. credit, debit or smart card) having a unique identification code or ID (col.2, lines 37-67); a reader or interface 60 to read the identification of the portable device and having a unique reader identification code or terminal ID (col.10, lines 25-41); a control center or server 50 including registering/storing means for registering the physical location associated with the reader, the registering means associating the received physical location identification information with the reader identification code of the reader associated with the physical location (col.9, lines 1-44); the control center or server adapted to receive the device identification code and the reader or terminal identification code/ID output by the reader (ol.6, lines 12-36), the control center adapted to supply fulfillment information associated with the supplied reader/terminal identification code to a user information destination associated with the received device identification code (col.2, lines 55-67 and col.3, lines 1-37).

Re claims 2, 22: Ogasawara teaches a system, wherein the registering step receives information identifying a manner of supplying information to the control center (col.2, lines 55-67 and col.6, lines 1+); and the control center is adapted to receive the fulfillment information in accordance with the identified manner (col.6, lines 10+).

Re claims 3, 23: Ogasawara discloses a system, wherein the manner is selected from one of e-mail, regular mail, telephone, and Internet access (col.3, lines 1+).

Re claims 4, 24: Ogasawara teaches a system, wherein the reader or card interface unit 60 is adapted to supply to the control center 50 the fulfillment/shopping list information each time the reader reads the device identification code of a portable device or IC/smart card (col.10, lines 18-67).

Re claims 5, 25: Ogasawara discloses a system, wherein the fulfillment information associated with the location is a catalog or a shopping list of items for sale at the physical location (col.2, lines 55-67).

Re claims 6, 26: Ogasawara teaches a system, wherein the fulfillment information associated the location includes promotional material/items regarding the physical location (col.3, lines 38-48).

Re claim 7: Ogasawara discloses a system, wherein the registering means receives the fulfillment or shopping list information (col.9, lines 45-65).

Re claim 14, 47, and 59: Ogasawara teaches a system, wherein the reader is disposed within the physical location at a position whereby the reader can read the device identification code of a portable device or IC/smart card disposed at a position exterior to the physical location (col.6, lines 12+).

Re claims 15, 33: Ogasawara teaches a system, wherein the registering means receives information identifying a manner of updating the fulfillment information (col.5, lines 47+); and the control center 50 is adapted to update the fulfillment information in accordance with the identified manner of updating (col.5, lines 50+).

Re claims 16, 34: Ogasawara discloses a system, wherein the registering means receives information identifying a fulfillment information source and identifying a period to update the fulfillment information (col.11, lines 35-67 and col.12, lines 1+); and the control center 50 is adapted to retrieve updated fulfillment information or changes onto the shopping list from the identified fulfillment information source in accordance with the identified period to update the fulfillment information (col.5, lines 43+ and col.3, lines 15-37).

Re claims 17, 35: Ogasawara teaches a system, wherein the fulfillment information source is a web site location (col.21, lines 57-60).

Re claim 21: Ogasawara discloses a system, which includes steps of registering during a registration process by a location, identifying an identity of the location being supplied during the registration process (col.8, lines 28-67); supplying to the location a reader having a unique reader identification code (col.10, lines 25+); associating the reader identification code with the supplied information identifying the identity of the location (col.22, lines 51+); visiting by the user of the location about which information is desired (col.8, lines 28-67); reading by the reader 60 the device identification code of the portable device or IC/smart card held by the user (col.10, lines 13+); supplying to a control center 50 the read device identification code and the reader identification code of the reader (col.10, lines 22+); and supplying by the control center 50 to a location associated with the user of the portable device fulfillment information associated with the location to which the reader having the supplied reader identification code was supplied (col.9, lines 8+).

Re claim 27: Ogasawara teaches a system, wherein the registering step includes supplying to the control center the fulfillment information to be supplied during the step of supplying by the control center (col.3, lines 38+).

Re claim 36: Ogasawara et al. discloses a system, wherein the step of supplying to the control center includes supplying the fulfillment information along with the device/consumer identification code and the reader identification code of the reader/terminal (col.9, lines 45-67 and col.10, lines 1-67).

Re claims 51 and 63: Ogasawara teaches a system, wherein registering means receives from the user information identifying a selection of an automatic product purchase option (col.17, lines 29+); and wherein the control center 50 is adapted to communicate to the user an offer for sale of the respective item for sale associated with the supplied reader identification code (col.10, lines 51-67; col.11, lines 1+; col.17, lines 36+).

Re claims 52 and 64: Ogasawara teaches a system, wherein registering means receives from the user information identifying a selection of an optional product purchase option (col.15, lines 29+); and wherein the control center 50 is adapted to communicate to the user an offer for sale of the respective item for sale associated with the supplied reader identification code (col.10, lines 51-67; col.11, lines 1+).

Re claim 58: Ogasawara et al. discloses a system, which includes steps of registering a user during a registration process, the user supplying/providing identification information during the registration process, the identification information including a mailing location/home address to which the user desires to receive fulfillment information (col.10, lines 42-67); supplying to the user a portable device having a unique identification code (col.10, lines 33+); associating the

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unique identification code of the portable device with the user supplied identification information (col.10, lines 37+); supplying to a retail store a reader having a unique reader identification code (col.10, lines 30+); providing by the retail store a control center 50 fulfillment/sale information (through Price Look Up; PLU) relating to information about the retail store (col.6, lines 37-67); associating the provided fulfillment/sale information with the reader identification code (serial number of the reader) of the reader/terminal supplied to the reader identification code of the reader supplied to the retail store (col.10, lines 45+); visiting by the user of the retail store (col.9, lines 45+; col.11, lines 35+); reading by the reader 60 the device or IC/smart/credit/debit card identification code of the portable device of the user (col.6, lines 12+); supplying to a control center the read device identification information code and the reader identification code having read the device identification code (col.10, lines 13-41); and supplying by the control center to the mailing location (home address or e-mail address) of the user fulfillment information associated with the supplied reader identification code (col.1, lines 3567 and col.2, lines 1+).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-13, 18-19, 28-32, 37-38, 42-43, 49-50, 56-57, 61-62, and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (U.S. 6,123,259).

Re claims 8,10, 12, 18-19, 28-32, 37-38, 42-43, 49-50, 56-57, 61-62, and 68-69: Ogasawara teaches a system, further comprising a reader adapted to read the device identification code of a portable device in the proximity to the respective reader, each of the readers associated with a respective physical location to be visited by the user and having a respective reader identification code, each of the readers having capability to supply as an output a read device identification code and the reader identification code of the respective reader (col.10, lines 25+).

Ogasawara et al. fails to teach a plurality of readers and portable devices.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide multiple set readers in the system of Ogasawara et al. in order to accommodate greater number of users at the same time and to reduce any possible waiting line. Furthermore, it would obvious to one skilled in the art to arrange and position the readers regarding to the location of a respective item for sale in order permit the consumer to check whether the item was register on the shopping list/fulfillment information and provide ability of making changes or updating the list so as to include/enter a certain desired item. Furthermore, it is well known in the art of a system and/or method to generate a unique identification/customer number for each credit/debit/smart card and system and/or method to provide reward/bonus point to a user (promotional program from American Express, Master Card and the like), therefore it would have been obvious to use the same system and method into the teachings of Ogasawara et al. Moreover, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Re claims 9, 11, and 13: Ogasawara et al. discloses a system, wherein the registering means receives for each of the readers respective fulfillment information relating to the respective physical location (col.7, lines 44+).

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (U.S. 6,123,259).

The teachings of Ogasawara et al. have been discussed above. Furthermore, Ogasawara et al. teaches a display 10 and means for communicating with costumer regarding the shopping list or fulfillment information through the control center 50 (col.4, lines 54+).

Ogasawara et al. fails to disclose means for supplying information to the user that the fulfillment information is not yet available if the fulfillment information has not yet been supplied to the control center.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to create a software program into the teaching of Ogasawara et al. including a subroutine with means for supplying information to the user that the fulfillment information is not yet available if the fulfillment information has not yet been supplied to the control center in order to help the consumer saving time before visiting the retail establishment. Furthermore, such modification would be advantageous for both the retail store so as to assure the fulfillment /shopping list of the customer is in order and to the consumer for an effective and to the point shopping including list of items to be purchased, locations/directions of the items in the store, store rebates/sales and price information. Moreover, such modification would have been an obvious extension as taught by Ogasawara et al., therefore an expedient.

11. Claims 39-41, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (U.S. 6,123,259).

The teachings of Ogasawara et al. have been discussed above.

Ogasawara et al. fails to teach a system, wherein supplying the reader to the location and the step of reading the device occurs before the registration, and identification by the control center of the identity of the location occurs after identifies receiving the fulfillment information.

However, it would have been inherent/obvious to have a reader or a plurality of readers prior to registering a user, reading the device information, and identifying a location to the user after the fulfillment information have been received. One skilled in the art would agree that in order to locate a product, which is already stored in the database, a request for the information has to be received by the control center prior to identifying the location of the product, and wherein the control center can send a message (through the control unit 20 and display 10 of Ogasawara et al) that the fulfillment information has not been received and the location of any product is unavailable. Furthermore, such modification would have been an obvious extension of the teaching of al.

12. Claims 48 and 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (U.S. 6,123,259).

The teachings of Ogasawara et al. have been discussed above.

Ogasawara et al. fails to teach a system, wherein the reader is adapted to read the device identification code during a time when the store is closed.

However, one skilled in the art would agree that shopping at a remote location (i.e. home or away from the retail store), at any time during the day or night (i.e. 24-hour, 7-day/week),

paying a bill, and buying/ordering goods/commodities is well known in the art and would be equivalent for a reader to read a credit/debit/smart card during the time the retail store is closed.

Therefore it would have been an obvious extension of the teaching of Ogasawara et al.

13. Claims 53-55 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (U.S. 6,123,259) in view of Oneda (U.S. 5,953,705).

The teachings of Ogasawara et al. have been discussed above.

Ogasawara et al. fails to teach that the portable device can be used as an admission pass to a facility and a travel ticket.

Oneda discloses ticketless system and processing method and memory medium storing its processing program, which includes a card 38 (See Figs. # 2A-2C of Oneda; col.3, lines 31+ and col.4, lines 50+).

In view of Oneda's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a similar IC/smart card, which contains a microprocessor, a database and a memory, into the teaching of Ogasawara et al. in order to enable the user an admission pass to a facility and to be used as an travel ticket. Furthermore, such modification would be beneficial to both the card holder so as to save time when boarding an airplane, purchasing tickets for a sportive/recreational event, movies or the like wherein reservation, payment, ticket issue information and boarding can all be done prior to visiting the airline's gate and to the airline carrier in order to reduce waiting line, provide faster and adequate services. Moreover such modification would have been an obvious extension as taught by Ogasawara et al.

Response to Amendment

14. The affidavit filed on 10/14/2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ogasawara reference.

15. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Ogasawara reference. The applicant has failed to satisfactorily explain the absence of proof/evidence that the claimed invention (filed on 12/5/2001 of a provisional application filed on 12/5/2000) existed or was in process before the filing date of the prior art (Ogasawara U.S. 6,123,259 issued on 7/26/2000, which was filed on 4/30/1998). The applicant admitted being an artist not an engineer or scientist and not having kept any notes at the time of the conception of the invention, furthermore the applicant stated behind a sworn testament "attached are copies of some notes pertaining to some general aspects, although, such notes, by themselves, do not definitively establish conception of the invention claimed in the present application. Nevertheless, these notes were taken prior to April 30, 1998, and it was during the course of the conception of that identified in these notes that I also conceived of the particular invention claimed in the present application" (see page 2, lines 4+ of the applicant's affidavit). No copies or notes were accompanied with the affidavit. The examiner respectfully denies the affidavit because, as stated in the M.P.E.P. under 37 C.F.R. 1.131 section (b), original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. Therefore the examiner retains the rejection as set forth in the Office Action (see paper no. 5/05/2003).

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Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **EDWYN LABAZE** whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
November 14, 2003



THIEN M. LE
PRIMARY EXAMINER

THIEN M. LE
PRIMARY EXAMINER